


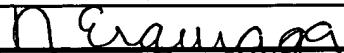


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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application No.	09/607,202	
	Filing Date	June 28, 2000	
	First Named Inventor	Frank J. Jakubaitis	
	Art Unit	3625	
	Examiner Name	Examiner Robert Pond	
Total Number of Pages in This Submission	19	Attorney Docket Number	6969P001

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; height: 80px; width: 100%;"></div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Eric T. King, Reg. No. 44,188 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	March 13, 2006

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Typed or printed name	Nicole Erquiaga		
Signature		Date	March 13, 2006



FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

Complete if Known

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayment of fee(s) ☒ Credit any overpayments
under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

FEE CALCULATION

1. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
11	20*	0	0
2	3*	0	0
Multiple Dependent			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	50	2202	25	Claims in excess of 20
1201	200	2201	100	Independent claims in excess of 3
1203	360	2203	180	Multiple Dependent claim, if not paid
1204	790	2204	395	**Reissue independent claims over original patent
1205	300	2205	150	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (1) (\$) 0.00

**or number previously paid, if greater, For Reissues, see below

2. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.
2053	130	2053	130	Non-English specification
1251	120	2251	60	Extension for reply within first month
1252	450	2252	225	Extension for reply within second month
1253	1,020	2253	510	Extension for reply within third month
1254	1,590	2254	795	Extension for reply within fourth month
1255	2,160	2255	1,080	Extension for reply within fifth month
1401	500	2401	250	Notice of Appeal
1402	500	2402	250	Filing a brief in support of an appeal
1403	1,000	2403	500	Request for oral hearing
1451	1,510	2451	1,510	Petition to institute a public use proceeding
1460	130	2460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))

Other fee (specify) _____

SUBTOTAL (2)

(\$)

Fee Paid

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Eric T. King	Registration No. (Attorney/Agent)	44,188	Telephone	(714) 557-3800
Signature		Date	10/13/05		

Appl. No.:09/607,202

Reply to the Examiner's Answer of 1/13/2006

Amended Dated 3/13/2006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Frank J. Jakubaitis

Application No.: 09/607,202

Filed: June 28, 2000

For: METHOD AND SYSTEM FOR
DISTRIBUTING DIGITAL WORKS

Examiner: Robert M. Pond

Art Group: 3625

REPLY BRIEF

BOX AF

Assistant Commissioner for Patents

Washington, DC 20231-9998

Dear Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. § 1.193(b) for consideration by the Board of Patent Appeals and Interferences. The Reply Brief is directed to the new points of argument raised in the Examiner's Answer.

I. Response to New Points of Argument Raised in Examiner's Answer to Independent Claims 1 and 9 in view of Reber further in view of Fiala and even further in view of Freeny.

A. New Points of Argument Related to the Network Navigation Device of Reber

On pages 10-12 of the Examiner's Answer, the Examiner continues to maintain his position that the network navigation device of Reber teaches Appellant's claimed *package that includes a card associated with a desired digital work*, wherein the card includes a card identifier displayed on the outer surface of the card...the card identifier *being a code that includes a desired digital work's identification data to uniquely identify the digital work and the package and the card being purchased...*and...wherein the *outer surface of the card or the package further displays a description of the content of the digital work to be downloaded.*

On page 11 of the Examiner's Answer the Examiner states that the network navigation device of Reber includes human-viewable images, graphics, and textual information on the card that identifies a service provider, a company name, and/or logo, as well as a barcode that identifies the network address of the resource. Further, on pages 11-12, the Examiner states that: "Consequently, Reber's invention provides network access information to automatically direct the user in possession of the network navigation device to a network resource and an optional password or code to uniquely identify the device."

In support of this, the Examiner cites column 7, lines 64 through column 8, line 7 of Reber which states:

"Machine-readable data in memory card 60 includes instructions for connecting to the Internet service provider. The instructions for connecting can include, for example, a telecommunication number (such as a phone number) which is to be dialed to access the internet service provider. The machine-

readable data can further include a code, such as a password, for authentication by the Internet service provider. Based upon the code, access to the resource is either allowed, limited, or inhibited. Further, the code can be utilized by the Internet service provider to uniquely identify the network navigation device.”

Appellant respectfully submits that the Examiner has misconstrued the teachings of Reber and Appellant’s independent claims 1 and 9.

In contrast to the invention set forth in Appellant’s independent claims 1 and 9, Reber relates to a navigation device 10 having a first human-viewable image that is indicative of a resource in an electronic network 20...The second human-viewable image 18 is indicative of a sponsor or service which provides the resource to a network access apparatus 22 via the electronic network 20...The machine-readable data 16 provides data which identifies the resource to the service (See generally Reber, column 2, lines 57-column 2, line 3, emphasis added).

An example in Reber is given of a first human-viewable image 42 that includes information which indicates to an end user that the network navigation device can be utilized to link to a resource from or about Motorola, Inc....For this purpose, included in the human viewable image 42 is textual information such as “Motorola”...The second human-viewable image 44 includes a logo which identifies a service which provides the resource to the end user...In this embodiment, the logo identifies a linking service provided at a node...on the World Wide Web (Reber, column 5, lines 59- column 6, line 10, emphasis added). The machine readable data 46 includes a bar code representative of a first URL for the node which provides the linking service...and a second URL for the Motorola home page on the World Wide Web...(Reber, column 6, lines 10-14).

As stated in Reber, Reber relates to a network navigation device that includes a human-viewable image intuitively associated with a resource and machine-readable data for navigating to the electronic address...A user accesses the resource by reading the machine-readable data using a data reader, rather than by typing in an electronic address...As a result, the addressing format in the address itself becomes more transparent to the user...Consequently, the problem of address complexity is addressed...(Reber, column 2, lines 38-49, emphasis added).

Thus, Reber relates to a network navigation device having human-viewable images associated with a resource (e.g. a web-page) and machine-readable data for automatically navigating to that electronic address (e.g. of the web-page) when it is read by a data device such that a user does not have to type in an electronic address or other information.

Appellant respectfully submits that the teachings of Reber related to a network navigation device having a code that can be automatically read by specialized equipment to enable access to a resource web page wherein the sponsor of the resource is identified by a logo or other graphical representation on the network navigation device, does not teach or suggest Appellant's limitations related to *a card associated with a digital work* in which the card includes a card identifier displayed on the outer surface of the card...the card identifier being a code that includes the desired digital works identification data *to uniquely identify the digital work and the package and the card being purchased* and in which the outer surface of the card or the package further *displays a description of the content of the digital work to be downloaded*.

B. New Points of Argument Related to Digital Works

On page 12 of the Examiner's Answer, the Examiner states that Reber's invention is used

to access a network resource and download content from the resource to the user's computer.

Appellant respectfully submits that although Reber does disclose transmitting content over the Internet, that this takes place in the context of downloading content associated with a resource (e.g. a web page) that has been automatically navigated to by an electronic address (e.g. of the web-page) that has been automatically read by a data reading device such that a user has been automatically directed to a web-page of a sponsor associated with the network navigation device.

Appellant respectfully submits that there is no teaching or suggestion in Reber *of digital works and packages or cards displaying a description of the specific type of content of a digital work that is to be downloaded*. It should be noted that in Appellant's patent application that examples of digital works are given. On page 4 of Appellant's patent application it states: "The digital work may be a book, a periodical subscription (such as a newspaper or magazine), a song, or a collection of songs, a movie, a software program, or the like."

In contrast, the content of Reber is related to unspecified content not known to the user beforehand related to whatever the sponsor of the web-page wants to direct to the user's attention to. Reber is related to a totally different invention for enabling access to a resource web page by utilizing a data reader to automatically link a user to a sponsor's web-site.

More importantly, as the previous Office Actions have acknowledged, Reber does not teach or suggest *purchasing from a retail merchant a package including a card associated with the desired digital work, sending a request from a merchant node associated with the retail merchant to a remote server to set a status of a desired digital work as available for one-time*

access and wherein a desired digital work is received at the customer node and stored on a memory of a customer node such that the digital work is available for subsequent use by the customer at the customer node after the customer logs off of the remote server.

Appellant's claimed invention in which a user *may send a request to access a desired digital work from a customer node through a communication network to a remote server*, in which the request *specifies the desired digital works identification data included in the card identifier displayed on the outer surface of the purchase package* is very different from Reber. Appellant's claimed invention typically requires that the user type the identification data after previously manually logging on to a web site. Thus, Reber teaches a very different invention than that described in the limitations of Appellant's independent claims 1 and 9.

Moreover, nowhere does Reber teach or suggest *an outer surface of the card or package displaying a description of content of a digital work to be downloaded*.

Quite clearly, this is because Reber does not relate to the purchase, authorization for purchase, and transmission *of specific digital works* to customers at the customer node. Reber is related to a totally different invention related to a network navigation device having a code that can be automatically read by specialized equipment to enable access to a resource web page wherein the sponsor of the resource is identified by a logo or other graphical representation on the network navigation device.

C. New Points of Argument Related to Pre-Paid Cards and Debiting for Use.

On pages 12-13 of the Examiner's Answer, the Examiner asserts that Reber teaches usage parameters that meter the use of a pre-paid card including pre-determined time limits, pre-

determined monetary units, and pre-determined number of uses limit.

However, all the citations by the Examiner refer to monitoring a usage parameter associated with the network navigation device. Particularly, all of the Reber citations by the Examiner relate to monitoring the usage of a user that has been automatically directed to the web-page of a sponsor by the network device of Reber.

Appellant respectfully submits that there is quite simply no teaching or suggestion in Reber of *purchasing from a retail merchant a package including a card associated with a desired digital work, sending a request from a merchant node associated with the retail merchant to a remote server to set a status of a desired digital work available for one-time access such that the desired digital work may be received at a customer node and stored on a memory of a customer node such that the digital work is available for subsequent use by the customer...*

Appellant respectfully submits that Reber's network navigation device that automatically enables access to a web page by utilizing a data reader to automatically link a user to a sponsor's web-site in no way teaches or suggests Appellant's claims related to obtaining *a one-time download of a digital work that was purchased from a retail merchant wherein the card and/or package describes the digital work that was purchased by the consumer.*

D. New Points of Argument Related to Fiala and Purchasing from a Retail Merchant a Package Including a Card.

On pages 13-14 of the Examiner's Answer, the Examiner states that the "Examiner firmly believes that Reber 'opens the door' to one of ordinary skill in the art to further investigate

beyond Reber just how one would market Reber's pre-paid card in stores."

Appellant respectfully disagrees with the Examiner and respectfully submits that Reber teaches away from Appellant's claimed invention, and further, Fiala does not teach or suggest the limitations for which it is set forth by the Examiner.

Further, Appellant respectfully submits that the Examiner is engaging in the act of impermissible hindsight reconstruction, which the Federal Circuit has repeatedly said should be avoided.

The Federal Circuit has ruled that it is impermissible to use the claims as an instruction manual or "template" to piece together teachings of the prior art to render a claimed invention obvious. *See Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554, (Fed. Cir. 1996). "Virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457. An examiner may often find every element of a claimed invention in the prior art. However, if merely identifying each claimed element in the prior art was sufficient to negate patentability, very few patents would ever issue. *Id.* Rejecting patent claims solely by finding "prior art corollaries" for the claimed elements permits an examiner to use the claimed invention itself as a blueprint for piecing elements in the prior art together. *Id.* To defeat the patentability of a patent application in this manner is inappropriate. *Id.*

Appellant respectfully submits that this is exactly what the Examiner is doing.

In the Examiner's Answer, the Examiner notes on pages 13-14, Reber does not disclose details about marketing Reber's network navigation device in retail stores but that Fiala allegedly teaches users using pre-paid cards that meter access to services, various ways to manufacture pre-paid cards, and displaying and selling packaged pre-paid cards at a retail store.

However, Appellant respectfully disagrees with the Examiner and respectfully submits that there is no motivation to attempt to alter Reber to be modified and combined with Fiala to in hindsight approximate Appellant's independent claims 1 and 9, and in fact, Reber actually teaches away from Appellant's independent claims.

As previously discussed, Reber is directed to providing easy access to a web-site resource, not purchasing a card at a retailer and authorizing access to a specific digital work for the purchaser of the card. In fact, Reber directly teaches away from this.

As stated in column 7, lines 9-39 of Reber:

The use of a printed image and printed data on a paper or cardboard substrate, such as in FIGS. 2 and 4, provides a number of advantages. A first advantage is that the resulting network navigation device can be produced inexpensively for wide distribution. For example, these network navigation devices can be: (i) included as inserts in magazines, newspapers, or other publications; (ii) stacked into decks and packaged for distribution by mail or for marketing in stores; and/or (iii) distributed as one distributes business cards. . . In addition, the network navigation devices can be collected and traded in a manner similar to trading cards. . . In addition, the use of a printed image and printed data allows for network navigation devices to be formed on pages of a book, magazine, newspaper, or other publication. In general, each page can define a single network navigation device, or can define a plurality of network navigation devices. If desired, a page defining a plurality of network navigation devices can be perforated to allow for separation into individual network navigation devices. . . . In one application, the printed image can include a figure in a book or the like. Here, the printed data may be utilized to link a user to a resource having information associated with the figure. . .

Thus, as set forth in Reber itself, the navigation devices of Reber are meant to be distributed freely to potential customers through inserts in magazines, books, newspapers, through the mail, distributed freely as business cards, etc. They are not, as set forth by the Examiner, amenable to be modified to be purchased in a retail store and to implement retailer activation.

Their very advantage is that they are inexpensive and can be distributed freely to direct people to a web-site of a sponsor for future commercial activity.

Thus, Reber directly teaches away from using the navigation devices in a retail or purchasing manner in order to approximate Appellant's independent claims, such as: *purchasing from a retail merchant a package including a card associated with a desired digital work...sending a request from a merchant node associated with the retail merchant to a remote server to set a status of a desired digital work as available for one-time access, etc.*

Accordingly, Appellant respectfully submits that because Reber directly teaches away from the Examiner's proposed combination with Fiala to teach Appellant's claims limitations, that there is no motivation for such a combination, and that therefore, Reber and Fiala are not properly combinable to approximate Appellant's independent claims 1 and 9. Thus, Appellant's independent claims 1 and 9 cannot be rendered obvious over Reber in view of Fiala.

Moreover, Appellant respectfully submits that, even if Reber was properly combinable with Fiala, as previously discussed, this combination would still not teach the Appellant's claim limitations. Appellant respectfully submits Fiala likewise teaches away from a combination with Reber to approximate Appellant's claim limitations, as will be discussed.

Appellant respectfully submits that Fiala:

“relates, in general, to packaging for well-known pre-paid debit cards...Such debit cards are associated with a pre-paid metered account, and the account is debited as purchases are made by a customer...In particular, the present invention relates to a package for holding a data-encoded card associated with a metered account and a method of using the package and card combination to activate the metered account with a certain pre-determined

value at the time of purchase of the card and package combination” (Fiala, column 1, lines 26-36) (emphasis added).

Appellant respectfully submits that Fiala relates to pre-paid debit cards to enable metered accounts for the purpose of purchasing goods and services.

In fact, there is no teaching or suggestion of Fiala of *digital works, packages or cards displaying a description of the content of a digital work to be downloaded, and sending a request from a merchant node associated with the retail merchant to a remote server to set the status of a desired digital work as available for one-time access.*

E. New Points of Argument Related to Fiala and Card Activation.

On page 14 of the Examiner’s Answer, the Examiner states that “Fiala teaches retailer locations selling the packaged prepaid cards to user’s, each retailer location being electronically linked to a remote computer and transmitting pre-paid card characterization data to the remote computer for the purpose of activating pre-paid cards (Fiala, col. 19, lines 29-44; col. 19, lines 64 through col. 20, line 5).”

However, again, Appellant respectfully submits that Fiala is not related at all to digital works, but only pre-paid debit cards for pre-paid meter accounts with a certain pre-determined amount of value. Fiala is only related to card activation in terms of these types of pre-paid debit cards and in no way teaches or suggests Appellant’s claim limitations related to sending a request from a merchant node associated with the retail merchant *to a remote server to set a status of a desired digital work as available for one-time access based on the card identifier of the card associated with the digital work...receiving at the remote server the request to access the desired digital work...searching the desired digital work stored on the remote server for the desired*

digital work specified by the identification data associated with the card identifier displayed on the outer surface of the purchase card and the received request...

Instead, as particularly shown, if one continues on from the citation cited by the Examiner, on column 20, lines 6-25, Fiala teaches:

“The customer can now remove the first card C from the package 30 and store the first card C in any convenient place such as, for example, a wallet or purse. To obtain goods or services, e.g., to obtain telephone service, the cardholder customer could, for example, dial a certain telephone number and connect to the digital computer 72. The customer preferably then enters the PIN P onto the telephone keypad, but the PIN P could instead be entered into a personal computer which is connected to the digital computer 72 by modems or the PIN P could be entered using another well-known data entry device as will now be apparent to those skilled in the art. A characterization of the PIN P is then transmitted to the digital computer 72, the digital computer 72 uses the characterization of the PIN P to identify the associated metered account, the digital computer 72 provides the customer with access to goods or services, for example, telephone services, and the digital computer 72 then debits the balance of the metered account. When the balance has been debited to zero, goods or services can no longer be obtained by use of that particular PIN P and the first card C can be discarded.”

As shown, Fiala relates to the activation of services, such as telephone service, and other types of goods and services that can be purchased in a store.

Fiala's intended function of providing a metered account with a pre-determined balance for multiple transactions would be destroyed by trying to modify it to teach *sending a request from a merchant node associated with a retail merchant to a remote server to set a status of a desired digital work as available for one-time access.*

Appellant respectfully submits that Fiala does not teach or suggest purchasing from a retail merchant *a package including a card wherein the card is associated with the digital work.* There's quite simply no teaching or suggestion in Fiala of these limitations. Further, as

previously discussed, the intended function of Fiala would be destroyed if it were attempted to be modified away from a pre-paid debit card with a metered account for multiple transactions for goods and services to *a one-time access based on a card identifier of a card for a digital work.*

Moreover, Appellant respectfully submits that nowhere does Fiala teach or suggest *digital works, sending requests to merchant nodes for digital works, searching digital works stored on a remote server for desired digital works specified by a card, etc.*

In view of the above, Appellant respectfully submits that the Examiner's proposed combination of Reber and Fiala is untenable. Both Reber and Fiala teach away from the Examiner's proposed combination to approximate Appellant's independent claims. Moreover, as previously discussed, even if Reber and Fiala were combinable, they would still not teach the limitations as set forth in Appellant's independent claims 1 and 9. Lastly, in attempt to, in hindsight, reconstruct Appellant's independent claims 1 and 9, the Examiner attempts to combine Reber, in view of Fiala, and even further in view of Freeny.

F. New Points of Argument Related to Freeny and Subsequent Use.

On page 15 of the Examiner's Answer, the Examiner states that Reber and Fiala are silent on whether the content after downloading can be accessed for subsequent use by the customer at the customer node after the customer logs off of the remote server.

The Examiner on page 15 of the Examiner's Answer alleges that Freeny teaches content download to various types of storage media referred to by Freeny as material objects...and that Freeny teaches downloading the content from a central computer site that stores and manages content to remotely connected computers that can receive the transmitted content and store onto

various media. Further, on pages 15-16 of the Examiner's Answer, the Examiner alleges that Freeny teaches selling the storage medium and downloaded content to a user who can then access for off-line use.

Appellant respectfully submits that Freeny, in combination with both Fiala and Reber, does not teach or suggest Appellant's limitations of independent claims 1 and 9.

Freeny teaches a plurality of "information manufacturing machines 14...located at a point of sale location and each point of sale location is located remotely with respect to the other point of sale locations in the system 10...The information control machine 12 is located at a remote location with respect to each of the point of sale locations and with respect to the information manufacturing machines 14...Each information control machine 12 is located at a remote location with respect to each of the point of sale locations...The point of sale location is a location where a consumer goes to purchase material objects embodying predetermined or pre-selected information." (Freeny, column 5, lines 32-50, emphasis added).

Thus, Freeny teaches a point of sale location to which a customer goes to purchase material objects (e.g. digital information stored on some sort of storage device) which they can later use at home.

Appellant respectfully submits that there is no motivation to combine Reber, with Fiala, and then with Freeny, except impermissible hindsight reconstruction, and that even if Reber, Fiala, and now Freeny, were properly combinable, Freeny does not teach or suggest Appellant's claim limitations related to: *transmitting the desired digital work from the remote server through the communications network to the customer node...receiving at the customer node the desired*

digital work...and storing a desired digital work on a memory of the customer node such that digital work is available for subsequent use by the customer at the customer node after the customer logs off of the remote server.

Thus, Appellant respectfully submits that Freeny does not teach or suggest the limitations of Appellant's independent claims 1 and 9, even if it were properly combinable with Reber and Fiala.

Freeny, like Fiala, and like Reber is directed towards a totally different invention and even if it were combinable with Fiala and Reber, this three-way combination of references would still not teach or suggest Appellant's independent claims 1 and 9.

Thus, as outlined in detail above, the three references cited by the Examiner, Reber, Fiala, and Freeny, are not properly combinable, and even if they were, there combination would still not teach or suggest Appellant's claim limitations as set forth in independent claims 1 and 9. Therefore, based on the above, Appellant respectfully submits that independent claims 1 and 9 are not rendered obvious over Reber in view of Fiala and even further in view of Freeny and are clearly patentable.

In view of the foregoing, Appellant respectfully submits that independent claims 1 and 9 are not rendered obvious by the hindsight combination of Reber, Fiala, and Freeny, and that these claims should be allowed. Appellant respectfully requests that the Board reverse the Examiner's decision as to independent claims 1 and 9. With respect to dependent claims, Appellant respectfully submits that these claims are allowable for being dependent upon allowable independent claims.

II. Conclusion

Appellant respectfully requests that the Board enter a decision overturning the Examiner's rejection of all pending claims, and hold that the claims are not rendered obvious by the prior art of record.

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Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



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